



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/640,437	08/17/2000	James Crouthamel	MBHB00-488	5131

25541 7590 01/14/2003

ALTHEIMER & GRAY
TEN SOUTH WACKER DRIVE, SUITE 4000
CHICAGO, IL 60606-7482

EXAMINER

ZURITA, JAMES H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 01/14/2003

#8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/640,437

Applicant(s)

CROUTHAMEL ET AL.

Examiner

James Zurita

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Request for Reconsideration

A First Office Action rejected claims 1-34 as unpatentable over Fields et al. (US Patent 6,338,059 and US Patent 6,128,655) in view of applicants' disclosures.

In a paper filed on 25 October 2002, Applicants traversed the rejections and requested reconsideration of the rejection.

Claims 1-34 remain and will be examined.

Response to Arguments

Applicants' arguments and request for reconsideration have been fully considered but are not persuasive.

Applicants' arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicants' arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

Applicants argue that the Examiner has failed to set forth a prima facie case of obviousness, and that "It is well settled that a prima facie case of obviousness requires, *among other things*, that all of the claim limitations be taught or suggested by the prior art [emphasis added]." In response to this argument, applicants' statement is

Art Unit: 3625

not fully accurate. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Thus, to establish a prima facie case, the *other things* alluded to by applicants would include items 1-4, above. The Examiner met the requirements set forth by statute and case law, citing issues of design choice, mere automation of manual activities and other criteria which render applicants' invention obvious over the prior art. Applicants have not challenged or rebutted Examiner's statements concerning level of ordinary skill nor presented arguments why it would *not* be obvious to one of ordinary skill in the art to combine or modify references with knowledge available to one of ordinary skill in the art to arrive at applicants' invention.

In response to applicants' argument that there is no suggestion to combine applicants' disclosures or the Fields references with information known

Art Unit: 3625

to one of ordinary skill in the art, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, applicants specifically included by reference several IETF RFC's, including 2854, 2660, 265, 2616, 2246, 1945, 1866 and 1865. A number of these RFC's refer to transforming, mapping, converting, translating, reformatting data in various scenarios. For example, RFC 2616, HyperText Transfer Protocol 1.1 shows conversion of data, in at least pages 11, 17, 21, 66. The RFC refers to mapping on pages 12 and 21. RFC 2246, the TLS Protocol, refers to translating on at least pages 4, 5, 6, 16, 17, 50 and to input and output structures on pages 8, 10. As is well known to one of ordinary skill in the art, term data structure refers to a scheme for organizing related pieces of information. The basic types of data includes files, lists, array, records, trees, tables. Each of these basic structures has many variations and allows different operations to be performed on the data.¹ While the documents refer to different types of data, including HTML, HTTP, transmission protocols, messaging, etc., the documents do not restrict reformatting *only* product or transaction data, as applicants require. It would be obvious to one of ordinary skill in the art to reformat any

¹ Computer and Internet Dictionary, Random House Webster's. Definition of data structure.

type of data for the purpose of using the reformatted data in a system that has a different format.

Therefore, applicants' arguments are not persuasive.

Claim Objections

Claim 6, 13, 15, 20, 25, 27 and 29, 32, 33 and 34 are objected to because of the following informalities:

There are two claims # 32. This appears to be a word processing error. Examiner believes that applicants intended the claim found on page 58 to be listed as claim 34, not as a duplicate claim 32. For purposes of this Examination, Examiner will interpret the claim found on page 58 as claim 34.

Claims 15 and 33 contain the term "transactional information." The term transactional information appears only in the Abstract and on page 8 of the disclosures. The term is not further described and would render claims 15 and 33 as not being enabled. Claims 6, 13, 20, 25, 27 and 29 refer to "transaction data." The term transaction data appears 38 times throughout the disclosures. Examiner believes that the two terms refer to the same object. For purposes of this examination, the term transactional information shall be interpreted to mean transaction data.

Claims 15 and 33 contain the term "enabling a user to *conduct* a transaction." This term appears only in the Abstract and on page 8 of the disclosures. The term is not further described and would render claims 15 and 33 as not being enabled. Claims 30, 31 and 32 contain the term "wherein the user *completes* a transaction." The term

“complete a transaction” may be found on pages 25-44 of the disclosures. Examiner believes that these two terms are synonymous. Applicants have not shown that there is patentable distinction between “enabling a user to *conduct* a transaction” and “wherein the user *completes* a transaction.” For purposes of this examination, Examiner will interpret the two terms as referring to *completing* a transaction.

Correction is required.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields et al. (US Patent 6,338,059)/*Fields* in view of applicants' disclosures.

Fields provides a centralized hosting server site (applicants' clearinghouse). The Host may connect one or more networks. The Networks may link one or more clients and one or more servers. Fields refers to the various actors as Clients and Content Server Providers (CPS). These actors may be identified as corresponding to applicants' Merchant and Partner sites. See at least Fig. 6, Fig. 7 and related text in Col. 6 line 33-Col. 7 line 51. At least these figures correspond to Applicants' figures 1, 4 and 7, in showing various modes of linking distributed components, including databases belonging to merchants or partners or affiliates.

Fields provides at least one [translator] converter program. The process of filtering, converting, recasting data takes place on the hosting site. One or more

programs convert input data to output data with the use of templates. Fields refers to links that can be translated to hosting site links (see at least Col. 8, lines 34-59). Fields also uses the words *formatting*, *filtering*, *reformatting* and various other terms to show that a centralized site may accept various formats and translate them into other formats. Fields also shows that various filters may be stored as one or more templates, possibly in a host site database. The various templates include host templates, to permit translation from clients and servers into a host database format. See at least Fig. 7, item 309, and other references to templates, including Col. 4, lines 23-37, Col. 7, lines 7-38, Col. 8, lines 25-33, Col. 8, line 60- Col. 9, line 8, Col. 10, lines 58-64.

Fields receives data from a site at the hosting site. Fields refers to one or more sets of data as containing fields and elements from a web page (see at least Col. 4, lines 23-47). Other sets of data may include set filters (see at least Col. 7, lines 7-15) and sets of user steps, set of instructions (see at least Col. 9, lines 45-Col. 10, line 17). The data is compliant with the sender's database; if were not compliant, the central site would be unable to use one or more of the various filters and templates.

Fields converts received data into other data set(s). The data is compliant with the second site's format since the host site uses site-specific filters and templates to convert the data to a format used by an intended recipient site (see Fig. 7 and text).

Fields sends converted data from the hosting site to intended recipient sites. These sets of data may be received from any one client site, filtered, reformatted according to one or more templates stored in one or more databases at a hosting site. The reformatted data is then *passed-through* to a recipient site. See at least references

Art Unit: 3625

to *pass-through* and *pass through* (Col. 6, line 56-Col. 8, line 33, Col. 8, line 60-Col. 9, line 8, Col. 10, lines 58-64).

Fields specifically describes that their invention may use methods and systems as claimed by applicants: extracting web-based content from content provider or source Web sites for use by the hosting or “pass-through” Web site. Fields notes that “pass-through” may involve filtering, reformatting and reuse of Web-based content (Col. 6, line 56 – Col. 7, line 51). As Fields notes, their list is merely exemplary and any component on a web page can be extracted and recast into the hosting site context by the pass-through mechanism. Fields does not limit the type of data that is being processed to product or transaction and image data, but discloses that their invention may be used for any type of data. Fields *does not* limit the types of filters and templates that are present in a host site database. Fields does not limit storage process to only a first and third data set, as in Applicants’ invention.

Fields *does not* use the term *translator* to refer to various software programs that execute on a host to filter, reformat, recast, convert information from one or more formats for one or more clients to/from one or more formats for one or more service providers. Fields *does not* use the term *dataset* or *data set*. A dataset (or data set) is a data file or collection of interrelated data.² Fields does not refer to a first data set or second data set or third data set or fourth data set. Fields shows that any one of these data sets may be stored at the hosting site, even if only temporarily, while the data is being reformatted.

² Computer Desktop Encyclopedia. American Management Association. Copyright 1996.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to combine Fields, applicants' disclosures and information generally available, to disclose translator programs that convert one or more sets of incoming data, of any type, to one or more sets of output sets of data and to store one or more sets of data at a hosting site.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Fields, applicants' disclosures and information generally available, to disclose translator programs that convert one or more sets of incoming data, of any type, to one or more sets of output sets of data and to store one or more sets of data at a hosting site for the obvious reason that such translation allows different sites and notes to communicate and exchange information. As applicants disclose, different vendors, participants, affiliates, partners and merchants have many different formats and types of data in their databases (see at least RFC 1865, EDI Meets the Internet, Page 29 concerning different fields. For translation among various types of Value Added Networks/VAN, see at least pages 2, 5, 8, 15, 30). Rendering the different formats facilitates communication and allows both merchants and partners to communicate concerning their products and commercial activity, and may increase customers' access to the information. Increased customer access increases the level of economic activity, generating revenue, jobs and increased customer satisfaction.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8:30 am to 5:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

JZ
James Zurita
Patent Examiner
Art Unit 3625
January 10, 2003

